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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,548	04/23/2001	Doug Rollins	MTIPAT.191A	3928

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KNOBBE MARTENS OLSON & BEAR LLP  
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EXAMINER
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BURLESON, MICHAEL L

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	01/10/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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**Office Action Summary**

Application No.

09/840,548

Applicant(s)

ROLLINS, DOUG

Examiner

Michael Burleson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11, 13-16 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 13-16 and 21-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see pages 7-11, filed 09/11/2006, with respect to the rejection(s) of claim(s) 1-9, 11, 13-16 and 21-28 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of McHale US 5668857.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 25 states "a program storage device storing instructions that when executed by a computer" should be changed to – a computer readable medium storing computer readable instructions that when executed by a computer – (page 53 of Interim Guidelines).

Claims 1-9 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims are directed to a seemingly patentable process ("method") but seek patent protection for an abstract idea of computer-executable instructions as evident by claims 25-28. The claims describe functional descriptive material per se and have no practical application. Further, the

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method claim is "configured to" cause a processor to perform certain steps, which does not necessarily execute its intended functionality.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9,11,13-16 and 21-28 rejected under 35 U.S.C. 102(b) as being anticipated by McHale US 5668857.

3. Regarding claim 1, McHale teaches a method of communicating a message via a computer network (column 3,lines 12-18). McHale teaches of transmitting a message from a first server to a second server wherein the second server comprises a plurality of outgoing dial-up modems and wherein the outgoing dial-up modems are configured to fax the message to recipients via a public switched telephone network (column 3,lines 54-61, column 4,lines 26-36 and column 10,lines 23-25). McHale teaches determining availability of the outgoing dial-up modems at the second server (column 10,lines 11-21 and 26-32). McHale teaches if none of the outgoing dial-up modems are available, applying a wait time wherein the wait time is based at least in part on the utilization of the outgoing dial-up modems (column 10,lines 26-32). McHale teaches determining

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whether at least one of the outgoing dial-up modems is available after the wait time (column 10, lines 26-32).

4. Regarding claim 2, McHale teaches storing the message at the second server (column 10, lines 6-10).

5. Regarding claim 3, McHale teaches reserving an available outgoing dial-up modem for transmitting the message to the recipient (column 10, lines 22-32).

6. Regarding claim 4, McHale teaches determining availability of the outgoing dial-up modems comprises identifying an active or an inactive state of the outgoing dial-up modems (column 11, lines 22-32).

7. Regarding claim 5, McHale teaches determining availability of the outgoing dial-up modems is performed periodically at predetermined times or at start-up of the second server or after one of the outgoing dial-up modems is removed or another of the outgoing dial-up modems is added (column 11, lines 4-20).

8. Regarding claim 6, McHale teaches saving the active or inactive state of the outgoing dial-up modem in a memory (column 8, lines 48-52).

9. Regarding claim 7, McHale teaches queuing the message for sending at a later time if there is no outgoing dial-up modem available for immediate sending (column 10, lines 26-37).

10. Regarding claim 8, McHale teaches the wait time is based upon at least one characteristic of the load upon the outgoing dial-up modems (column 11, lines 4-21).

11. Regarding claim 9, McHale teaches sending a transmittal report to a transceiver having originated the message (column 10, lines 22-25).

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12. Regarding claim 11, McHale teaches receiving the message, wherein receiving the message includes handling the message according to the T.37 standard (column 3, lines 45-61).

13. Regarding claim 13, the steps of method claim 1 performs all of the means of system claim 13. Thus claim 13 is rejected for the same reasons as discussed in the rejection of claim 1.

14. Regarding claim 14, the steps of method claim 2 performs all of the means of system claim 14. Thus claim 14 is rejected for the same reasons as discussed in the rejection of claim 2.

15. Regarding claim 15, the steps of method claim 3 performs all of the means of system claim 15. Thus claim 15 is rejected for the same reasons as discussed in the rejection of claim 3.

16. Regarding claim 16, the steps of method claim 7 performs all of the means of system claim 16. Thus claim 16 is rejected for the same reasons as discussed in the rejection of claim 7.

17. Regarding claim 21, McHale teaches a method of communicating a fax message via a computer network (column 3, lines 12-18). McHale teaches of transmitting a message from a first transceiver to a first server via a public switched telephone network (column 4, lines 32-36). McHale teaches forwarding the message by the first server, via a computer network to a second server wherein the second server comprises a plurality of outgoing dial-up modems and wherein the outgoing dial-up modems are configured to fax the message to recipients via a public switched

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telephone network (column 3, lines 54-61, column 4, lines 26-36 and column 10, lines 23-25). McHale teaches receiving and storing the message at the second server (column 10, lines 6-10). McHale teaches determining availability of the outgoing dial-up modems at the second server (column 10, lines 11-21 and 26-32). McHale teaches if none of the outgoing dial-up modems are available, applying a wait time wherein the wait time is based at least in part on a number of the dial-up modems and based at least in part on a number of subscribers associated with the second server (column 10, lines 26-32 and lines 37-45). McHale teaches determining availability of each of the outgoing dial-up modems after the wait time (column 10, lines 26-32). McHale teaches if one of the outgoing dial-up modems is available after the wait time, sending the message via an available one of the outgoing dial-up modems and the public switched telephone network to a second transceiver, wherein the second transceiver is physically located in the same local-toll area of a public telephone network as the second server (column 10, lines 28-37).

18. Regarding claim 22, McHale teaches receiving and storing includes processing the message according to a store-and-forward protocol (column 10, lines 3-21).

19. Regarding claim 23, McHale teaches reserving the available outgoing dial-up modem for sending the message (column 10, lines 22-32).

20. Regarding claim 24, McHale teaches queuing the transmission of the message, wherein queuing transmission of the message includes the wait time that is based upon at least one characteristic of the load upon the outgoing dial-up modems (column 10, lines 26-37 and column 11, lines 4-21).

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21. Regarding claim 25, McHale teaches a program storage device storing instructions that when executed by a computer performs a method of communicating a message via a computer network (column 3, lines 12-18, lines 32-35 and lines 54-61). McHale teaches of instructions configured to forward a message from a first server to a second server wherein the second server comprises a plurality of outgoing dial-up modems and wherein the outgoing dial-up modems are configured to fax the message to recipients via a public switched telephone network (column 3, lines 54-61, column 4, lines 26-36 and column 10, lines 23-25). McHale teaches instructions configured to determine availability of the outgoing dial-up modems at the second server (column 10, lines 11-21 and 26-32). McHale teaches if none of the outgoing dial-up modems are available, applying a wait time wherein the wait time is based at least in part on the utilization of the outgoing dial-up modems (column 10, lines 26-32). McHale teaches instructions configured to determine whether at least one of the outgoing dial-up modems is available after the wait time (column 10, lines 26-32).
22. Regarding claim 26, McHale teaches instructions configured to receive and store the message, wherein receiving and storing the message includes processing the message according to a store-and-forward protocol (column 10, lines 3-21).
23. Regarding claim 27, McHale teaches instructions configured to reserve an available outgoing dial-up modem for transmitting the message to the recipient (column 10, lines 22-32).
24. Regarding claim 28, McHale teaches instructions configured to queue the message, wherein queuing the message comprises waiting for a predetermined period

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of time that is based upon at least one characteristic of the load upon the outgoing dial-up modems (column 10, lines 26-37 and column 11, lines 4-21).

**Conclusion**

1. Any inquiry concerning this communication should be directed to Michael Burleson whose telephone number is (571) 272-7460 and fax number is (571) 273-7460. The examiner can normally be reached Monday thru Friday from 8:00 a.m. – 4:30p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached at (571) 272-7437.

Michael Burleson  
Patent Examiner  
Art Unit 2626



MIb  
December 9, 2006



KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER